



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/574,687

04/05/2006

Ikuo Morita

Q94143

3712

23373 7590 05/12/2009
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

KIM, TAEYOON

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/574,687	Applicant(s) MORITA ET AL.	
	Examiner Taeyoon Kim	Art Unit 1651	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-9 and 18.
 Claim(s) withdrawn from consideration: 10-17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Leon B Lankford/
Primary Examiner, Art Unit 1651

Continuation of 5. Applicant's reply has overcome the following rejection(s): If entered, the proposed amendment would overcome the claim rejection under 35 U.S.C. §112.

Continuation of 11. does NOT place the application in condition for allowance because: In the response to the previous office action, applicant argued that Nelles et al. disparage and teach away from the use of siloxane as a cell adhesion molecule based on the disclosure of Nelles et al. (par. 6 and 7). However, the disclosure of Nelles et al. discussing various patterning techniques available in the art including polydimethyl siloxane (PDMS), poly-D-lysine and laminin, and there is no teaching or suggestion that teaches away to use siloxane or other materials commonly used for patterning. The object of Nelles et al. which is discussed in the paragraphs is mainly about transferring cells grown on patterned substrate or device (pre-patterned surface) to another or second surface which could provide full control on cells in culture. Furthermore, Example 2 of Nelles et al. clearly teach the use of PDMS. Therefore, the argument is considered not persuasive to overcome the rejection.

Applicant also alleged that a person of ordinary skill in the art would not have a reason to combine the disclosures of Nelles et al. with that of Haddow et al. The teaching of Haddow et al. combined with Nelles et al. in view of Kobayashi et al. is a method step of direct transfer of cells from one substrate to another without using enzymatic dissociation of the cells from the first substrate. Nelles et al. teach enzymatic dissociation or lowering temperature to release Haddow et al.'s teaching regarding to collagen is nothing to do with the claim rejection. PDMS can be used for the method of Haddow et al. (p.5, line 15). Still further, different from the applicant's analysis of the claim rejection, the teaching of Haddow et al. is supporting Kobayashi et al.'s teaching combined with that of Nelles et al. By replacing the substrate (pre-patterned) of Nelles et al. with the substrate of Kobayashi et al., cells can be adhered on siloxane based substrate, which can be directly transferred to the second substrate such as organ according to Haddow et al.

It is noted that the above argument is intended to be a rebuttal to the claim rejection under 35 U.S.C. §103 based on Nelles et al. in view of Kobayashi et al. and Georger et al., which was not present in the previous office action. In the previous office action mailed on 1/6/09, there was one 35 U.S.C. §103 rejection based on Nelles, Kobayashi, Georger, Haddow and Ostuni.

Applicant also alleged that the method of Nelles et al. requires transferring the matrix in which cells are embedded, and the cells are damaged when removing the matrix adhesion from cells, and therefore, Nelles cannot provide the advantageous effect of the present invention.

This argument is merely the argument of counsel and is unsupported by evidence or declarations of those skilled in the art. Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See M.P.E.P. § 2129 and § 2144.03 for a discussion of admissions as prior art. Counsel's arguments cannot take the place of objective evidence. *In re Schulze*, 145 USPQ 716 (CCPA 1965); *In re Cole*, 140 USPQ 230 (CCPA 1964); and especially *In re Langer*, 183 USPQ 288 (CCPA 1974). See M.P.E.P. § 716.01(c) for examples of attorney statements that are not evidence and that must be supported by an appropriate affidavit or declaration.

The teaching of Georger et al. combined with Nelles et al. is the patterning technology utilizing silicone resin (organopolysiloxane) can be used for cell adhesion to support the use of Kobayashi et al.'s substrate for cell culture. It is not meant to be that the actual method disclosed by Georger et al. is combined with Nelles et al.

With regard to the teaching of Haddow et al., applicant argued that Haddow et al. do not teach or suggest that cells are promoted to differentiate and form tissues when they are arranged in a pattern.

The features upon which applicant relies (i.e., promote differentiation or form tissues) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to the argument of the contact angle to water being not more than 40°C, it is extremely well known in the art that wettability is interpreted as hydrophilicity and hydrophobicity, and the cell adhesion can be determined by such wettability. The method steps of Kobayashi et al. are drawn to produce a patterned substrate having differential wettability, and since organopolysiloxane can be used for pattern-wise cell adhesion according to Georger et al., the method of Kobayashi et al. utilizing organopolysiloxane and a photocatalyst can be also used for patterning substrate for cell culture.

Based on the above discussion, the proposed amendment does not place the current application in condition of allowance.

Taeyoon Kim
AU-1651